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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,286	08/28/2001	Toshio Miyata	SHIM-008	6229

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EXAMINER

YOUNG, JOSEPHINE

ART UNIT PAPER NUMBER

1623

DATE MAILED: 06/11/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,286

Applicant(s)

MIYATA, TOSHIO

Examiner

Josephine Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-37 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 and 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 20,21 and 27-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group III in Paper No. 16, mailed April 2, 2003, is acknowledged. The traversal is on the ground(s) that the search for Groups I-III does not constitute a burden to the examiner and that the technical feature, namely the concept of absorbing carbonyl compounds from peritoneal dialysate, is novel and thus a special technical feature that links the claims of Groups I-III.

This is not found persuasive. A search for compositions with carbonyl compound-trapping agents and peritoneal dialysate of Group I would not be coextensive with the cartridge of Group II or method of use of such compositions of Group III. A reference directed to such composition does not necessarily lead to a reference wherein the composition is used in a cartridge or a method of using such composition. Searching the three inventions constitutes a burdensome search, as a thorough search comprises a search of foreign patents and non-patent literature, as well as the appropriate U.S. patent classifications. To search the three independent and distinct inventions would indeed impose an undue burden upon the examiner in charge of this application.

The traversal on the ground(s) that the technical feature, namely the concept of absorbing carbonyl compounds from peritoneal dialysate, is novel and thus a special technical feature that links the claims of Groups I-III also is not found persuasive. As set forth in the Office Action, mailed January 14, 2003, TANAKA teaches that metformin hydrochloride (MT), a biguanide compound, as well as aminoguanidine hydrochloride (AG), inhibit the formation of advanced

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glycation end products (AGEs), i.e. react with dicarbonyl metabolites. Therefore, by October of 1997, several compounds were known in the art as carbonyl compound-trapping agents. Thus, the technical feature linking the inventions of Groups I, II and III does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. A mere assertion of novelty is not sufficient to demonstrate a linking special technical feature between the Groups.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 13-19 and 22-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election of Species

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: Methods for preparing a peritoneal dialysate having reduced carbonyl content by using

- an absorbent cartridge that traps carbonyl compounds with a carbonyl compound-trapping agent; or
- a carbonyl compound-trapping agent that is not used in conjunction with an absorbent cartridge;

AND

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- the carbonyl compound-trapping agent is a patentably distinct species, for example a species selected from one of groups (1)-(31), set forth on page 8, line 20 to page 10, line 15 of the specification.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: International Patent Publication No. WO 93/19792 to BAXTER DEUTSCHLAND GMBH, which corresponds to patent US 5,827,820 to DUMOULIN discloses an aqueous peritoneal dialysis solution derived from two solutions, the first containing an osmotically active substance, such as glucose, and carboxylic acid anions, and the second containing a solution of bicarbonate ions and an amino acid or peptide component. See abstract. Therefore, as of the publication date of WO 93/19792, namely, 14 October 1993, methods of obtaining a peritoneal dialysate with carbonyl compounds using a solution of bicarbonate ions and an amino acid or peptide component were known in the art and cannot be considered a special technical feature.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josephine Young whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 6:00 p.m.

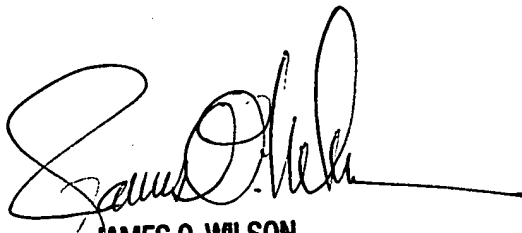
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (703) 308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

JY

June 5, 2003



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600